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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/524,457

02/10/2005

Patrice Bujard

HC/12-22724/PCT

8661

324 7590 03/25/2009

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EXAMINER

FISHER, ABIGAIL L

ART UNIT

PAPER NUMBER

1616

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/524,457	<b>Applicant(s)</b> BUJARD ET AL.	
	<b>Examiner</b> ABIGAIL FISHER	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/19/08</u> .  | 6) <input type="checkbox"/> Other: _____                          |

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### **DETAILED ACTION**

The examiner for your application in the USPTO has changed. Examiner Abigail Fisher can be reached at 571-270-3502.

Receipt of Amendments/Remarks filed on December 19 2008 is acknowledged.  
Claims 1-18 are pending.

### ***Information Disclosure Statement***

The information disclosure statement filed December 19 2008, specifically Other Document to Maisch et al., fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3 and 9 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 4, 6 and 7 of U.S. Patent No. 5,766,335. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant invention and the patent are directed to a pigment comprising a core consisting of a substantially transparent or metallic reflecting material and at least one coating consisting essentially of one or more silicon oxides having a molar ratio of oxygen to silicon being from 0.25 to 0.95. They also claim the same core material selected from the group consisting of Ag, Al, Au, Cu, Cr, etc. The difference between the two is that in the instant invention the composition further contains a suitable carrier material. The composition of the patent is directed to the formulation of color luster pigments for the use in printing inks and pigmented compositions. It is therefore the position of the examiner that these compositions contain other materials that serve as carrier materials for the pigments and is thus obvious.

### ***Response to Arguments***

Applicants argue that US Patent No. 5766335 is directed towards color luster pigments for use in printing inks, paint and automotive lacquers or the color luster pigments may be used for the coloration of high molecular weight materials while the instant invention is directed towards cosmetic and personal care preparations comprising coated gloss pigment and a cosmetically acceptable carrier.

Applicants' arguments filed December 19 2008 have been fully considered but they are not persuasive.

Firstly, the examiner acknowledges the typo with respect to the molar ratio of oxygen to silicon and has corrected the typo.

The only difference between the instant application and Patent '335 is that the instant application claims that the composition is a cosmetic and personal care preparations, which is found in the preamble and the inclusion of a cosmetic carrier. The pigments claimed are the same as instantly claimed. Firstly, the incorporation of the terminology cosmetic and personal care preparations in the preamble are not given patentable weight. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The body of the claim recites cosmetically suitable carrier material but neither the claims nor the specification indicate specific material.

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Therefore, the organic material taught and claimed in Patent '335 can broadly be interpreted as a cosmetically suitable carrier as organic polymers are commonly found in cosmetic materials.

Therefore, the rejection is maintained since applicant has not provided any persuasive arguments to overcome the rejection.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bujard et al. (US 5,766,335).**

Applicants claim a preparation comprising a pigment containing a core consisting of a substantially transparent or metallic reflecting material and at least one coating

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consisting essentially of one of more silicon oxides having a molar ration of oxygen to silicon being from 0.03 to 0.95.

***Determination of the scope and content of the prior art***

**(MPEP §2141.01)**

Bujard et al. teach a colored pigment comprising a core consisting of a substantially transparent or metallic reflecting material and at least one coating consisting essentially of one of more silicon oxides having a molar ratio of oxygen to silicon being from 0.25 to 0.95 (col. 2, line 62 to col. 3, line 2). Column 3, lines 31-46 teach examples of the core material. Column 4, lines 8-9 teach that the pigments can further comprise an additional coating which is different from the first; lines 26-29 teach examples of the metal oxides and mixtures thereof that can be employed in the second coating; finally line 34-35 teach that the arrangement of coatings relative to the core may be in any order. Column 8, lines 28-30 teach that high molecular weight organic materials can be used with the pigments.

***Ascertainment of the difference between the prior art and the claims***

**(MPEP §2141.02)**

Bujard et al. do not teach the preparation comprising a suitable carrier material or the concentrations of the components.

***Finding of prima facie obviousness***

***Rational and Motivation (MPEP §2142-2143)***

The composition of Bujard et al. is directed to the formulation of color luster pigments for the use in printing inks and pigmented compositions. It is therefore the position of the examiner that these compositions contain other materials that serve as carrier materials for the pigments and is thus obvious.

With respect to the concentration of the components, this determination would have been made through routine experimentation to achieve the desired results of the claimed invention. This is in the absence of any clear showing of unexpected results attributable to the specific concentrations of the components employed by applicant in the instant case.

***Response to Arguments***

Applicants argue that US Patent No. 5766335 is directed towards color luster pigments for use in printing inks, paint and automotive lacquers or the color luster pigments may be used for the coloration of high molecular weight materials while the instant invention is directed towards cosmetic and personal care preparations comprising coated gloss pigment and a cosmetically acceptable carrier.

Applicants' arguments filed December 19 2008 have been fully considered but they are not persuasive.

Firstly, the examiner acknowledges the typo with respect to the molar ratio of oxygen to silicon and has corrected the typo.



The only difference between the instant application and Patent '335 is that the instant application claims that the composition is a cosmetic and personal care preparations, which is found in the preamble and the inclusion of a cosmetic carrier. The pigments claimed are the same as instantly claimed. Firstly, the incorporation of the terminology cosmetic and personal care preparations in the preamble are not given patentable weight. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hira*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The body of the claim recites cosmetically suitable carrier material but neither the claims nor the specification indicate specific material. Therefore, the organic material taught and claimed in Patent '335 can broadly be interpreted as a cosmetically suitable carrier as organic polymers are commonly found in cosmetic materials. Furthermore, instant claims 6-12 and 16-17 are directed to a pigment, which is the same pigment as taught in Patent '335 and claim 13 recites a composition comprising a high molecular weight organic material, which is the same as that taught in Patent '335.

Therefore, the rejection is maintained since applicant has not provided any persuasive arguments to overcome the rejection.

***Conclusion***

No claims are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ABIGAIL FISHER whose telephone number is (571)270-3502. The examiner can normally be reached on M-Th 9am-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Abigail Fisher  
Examiner  
Art Unit 1616

AF

/Mina Haghighatian/  
Primary Examiner, Art Unit 1616